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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,619	11/15/2000	Rebecca S. Busch	MBA-P-00-001	3814

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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,619

Applicant(s)

BUSCH, REBECCA S.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12 and 17-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election made on 28 April 2005.
Claims 1-34 are pending. Claims 4-12 and 17-34 have been elected with traverse.
Claims 1-3 and 13-16 are non-elected.

Election/Restrictions

2. Applicant's election with traverse of claims 4-12 and 17-34 in the reply filed on 28 April 2005 is acknowledged. The traversal is on the ground(s) that the restriction requirement after an office action on the merits is improper and the search has already been conducted and has not subjected the Examiner to a serious burden. This is not found persuasive because the MPEP clearly states in section 811 that a restriction can be made at any time before final action in the case at the discretion of the examiner. In this case, the Examiner determined that the restriction should be made prior to a final action. The Examiner also clearly stated that there are distinct inventions which have separate classifications and a different field of search.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 1-3 and 13-16 drawn to an invention nonelected with traverse in 28 April 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4-12 and 22-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-10 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. It appears that steps are missing relating to how the flowchart is created from “the data mining.” In other words, it is unclear how data mining leads to a flow chart. It appears that steps are missing relating to how a case management tool is created from flowcharts and how errors are mitigated with a case management tool. It is unclear how a “tool” is used to mitigate errors. What steps are performed by the tool to mitigate errors? Appropriate clarification of these issues is requested.

The elements within claim 11 include personnel, specification code, an auditing chart, a database, and a pilot area. The element “personnel” appears to be comprised of people. This does not appear to be a structural element of a system. It is unclear if the element of specification code is computer code, and thus this does not appear to be a structural element of a system. The element “a pilot area” appears to be a space within a business. This does not appear to be a structural element of a system.

The elements of claim 12 include a "continuous audit." This does not appear to be a structural element of a system. It appears to be a process step. Appropriate clarification is requested of all issues.

Claims 26-34 incorporate the deficiencies of claims 10-12.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 4-12 and 22-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 9 only recites an abstract idea. The recited steps of merely conducting a continuous audit..., collecting errors..., entering the errors into a database, data mining the errors in the database, creating a flow chart, creating a case management tool..., and mitigating the errors... does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to perform an audit. In addition, it does not appear that the database is stored within a computer. The recitation of "a database" and "data mining" appear to be a nominal recitation of technology, and it is not clear whether these steps involve a computer or other related technology.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention collects errors (i.e., repeatable) used for an audit (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention as a whole, is not within the technological arts as explained above, claim 9 is deemed to be directed to non-statutory subject matter.

Similar analysis can be applied to claims 4-8, 10-12 and 22-34.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 4-6, 8-12, 17, and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Weiss et al. (6,460,037).

(A) As per claims 9, 11-12, and 27, Weiss discloses a method and system for assessing an organizational process or system comprising:

(a) conducting a continuous audit of a process to identify process error associated with the business (Fig. 1 note credit card application process);

(b) collecting the errors from the continuous audit (Fig. 4, col. 2 lines 35-47, col. 3 lines 15-22);

(c) entering the errors into a database (col. 4 lines 15-20);

(d) data mining the errors in the database (col. 4 lines 1-20);

(e) creating a flowchart from the data mining (col. 5 lines 11-37);

(f) creating a case management tool from the flowcharts (col. 5 lines 11-37, col. 8 lines 23-40, col. 10 lines 19-30); and

(g) mitigating the errors with the case management tool (col. 5 lines 11-37, col. 8 lines 23-40, col. 10 lines 19-30).

(B) Claim 4 differs from claim 9 and claim 22 by including the steps of choosing a pilot area associated with the area in which the significant error occurs to test the auditing

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chart, auditing the pilot area with the auditing chart at the location of the transaction, collecting information during the auditing of the pilot area, modifying the auditing of the business on-site based on the information collected in the pilot area, and auditing the pilot area with the updated specification code and the auditing chart. As per these limitations, note Weiss's teachings of a blackboard for posting hypotheses in an expert system, where the if-then statements are modified based on application data (col. 6 lines 5-56).

(C) Claims 5 and 6 repeat the limitations of claim 4, and is incorporated herein.

(D) As per claim 10, 31, Weiss discloses the errors pertaining to a credit card application process (Fig. 1).

(E) As per claim 17, Weiss discloses creating a record of a transaction at the location of the transaction (Fig. 4, col. 3 lines 23-58) and conducting an audit on the transaction as the record is created (Fig. 4, col. 2 lines 35-47, col. 3 lines 15-22).

(F) As per claim 22, Weiss discloses providing user agents to represent the human works that initiate and participate in the workflow for each function of the process for an application (col. 3 lines 1-45).

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(G) As per claim 23 and 26, Weiss discloses an intelligent system of agents (col. 3 lines 1-45). It is noted that agents update themselves if they are intelligent (see col. 3 lines 1-45).

(H) As per claim 25 and 34, Weiss discloses the field being a payor (col. 3 lines 36-45).

(I) Claim 8 repeats the limitations of claims 4, 22, and 23, and is therefore rejected for the same reasons as those claims, and incorporated herein.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 18-21, 24, 28, 29, 30, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (6,460,037) as applied to claims 4, 9, 11, and 12, and further in view of Vining et al. (6,819,785).

(A) As per claim 7, Weiss teaches auditing financial records (col. 3 lines 37-45).

However, Weiss does not teach auditing clinical or medical records. Vining teaches this at col. 11 lines 18-45. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Vining within the method of

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Weiss with the motivation of efficiently allowing medical technologists and hospitals to search databases (Vining; col. 2 lines 5-48).

(B) As per claims 24, 28, 29, 30, and 32-33, Weiss fails to expressly disclose the following:

- processing data on self-management of current and future products or services with reimbursement schedules for each field of the business;

- the business being a healthcare facility;

- the personnel is at least one of a manager, an auditor, or a technologist; and

- the information stored in the database including records related to the patient's medical condition and records that are not related to the patient's medical condition.

As per these limitations, Vining discloses:

- the data relating to CPT and ICD codes for reimbursement for healthcare services (col. 11 lines 18-45);

- the business being a healthcare facility (col. 3 lines 34-50);

- the personnel being radiologists (col. 4 lines 45-66);

- the records in the database storing data related to patient name and image (Fig. 4);

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Vining within the method of Weiss with the motivation of efficiently allowing medical technologists and hospitals to search databases (Vining; col. 2 lines 5-48).

(C) Claims 18-21 repeat the limitations of claims 17, and 29-30, and are therefore rejected for the same reasons as those claims, and incorporated herein.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches medical facility and business: automatic interactive dynamic real-time management (5,748,907), method of performing intellectual property audit optionally over network architecture (6,263,314), document management system (6,289,460), health care policy on-line maintenance dissemination and compliance testing system (6,449,598), method and apparatus for selecting taxpayer audits (6,611,809), and system and method for auditing loan portfolios and loan servicing portfolios (6,643,625).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

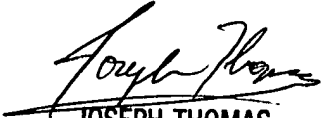
(571) 273-6767 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

July 25, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600